

REMARKS

Previously, claims 1, 2, 4, 7-9, 13-36, 80, 83 and 84 were pending and claims 3, 5, 6 and 10-12 were withdrawn. In the instant amendment, claims 1-6, 8-16, 19, 20, 24-27, 34, 35, 80, 83 and 84 have been canceled without prejudice to Applicants' rights to pursue canceled subject matter in one or more other applications. Claims 7, 17, 18, 21-23, 28-33 and 36 have been amended. New claims 85-89 have been added. Upon entry of the instant amendment, claims 7, 17, 18, 21-23, 28-33, 36 and 85-89 will be pending and under consideration.

I. AMENDMENTS TO THE CLAIMS

Claims 1-6, 8-16, 19, 20, 24-27, 34, 35, 80, 83 and 84 have been canceled without prejudice to Applicants' rights, as explained above.

Amended claim 7 is supported by the specification, for example, at page 14, lines 16-17 and 23, and page 15, line 17.

Claims 17, 18, 21, 22, 23, 28-33 and 36 have been amended to depend from new independent claim 85.

Amended claims 18, 21, 22 and 36 are supported by the specification, for example, at page 25, line 16 to page 26, line 11.

New independent claim 85 is supported by the specification, for example, at page 13, lines 11-30 and page 14, lines 13-21.

New claim 86 is supported by the specification, for example, at page 20, line 7. Support for new claim 87 is found in original claim 49. Support for new claims 88 and 89 are found throughout the specification and claims as originally filed.

The amendments to the claims are fully supported by the specification and claims as originally filed and that no new matter is introduced with these amendments. Applicants respectfully request entry of the amendments into the record.

No claim amendment fees are believed to be due since the numbers of total claims and independent claims have been reduced with the instant amendments to the claims.

II. RESTRICTION REQUIREMENT

Applicants respectfully request that the Patent Office indicate for the record of the instant application, a clear statement regarding the scope of restricted subject matter, and indication of the finality of the restriction requirement.

In brief, in the Restriction Requirement mailed November 25, 2005 the Patent Office stated, with regard to method claims of the present application, that “upon an election of a single compound [by Applicants], the office will review the claims and disclosure to determine the scope of the independent invention . . .” and that a “clear statement of the examined invention, defined by those class(es) and subclass(es) will be set forth in the first office action on the merits.” Restriction Requirement mailed November 25, 2005, page 3. Applicants’ Response to the Restriction Requirement mailed January 4, 2006, indicated that the elected species corresponded to a compound of formula (I) wherein W, Y, Z, X, R¹ and R² had the definitions as specified in the reply. With the first office action on the merits, the extent of the Patent Office’s statement of the examined invention is that the “restriction has been reformulated as such: R¹ and R² are selected from H, halogen, CN, CO₂R, C₁₋₈alkyl, CONR'R'.” Hence, it is Applicants’ understanding that independent claim 85 is consistent with the restriction; Applicants do not traverse the restriction, unless their understanding is not correct. However, Applicants do reserve the right to file one or more divisional applications on remaining subject matter, and therefore, respectfully request a clear statement regarding the restricted subject matter and of the finality of the restriction requirement.

III. CLAIM REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

Claims 1-9, 13-30, 34-36, 80, 83 and 84 stand rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement in the specification. The Patent Office, however, acknowledges that the specification is enabling for the treatment of asthma, atopic dermatitis, HIV infection, atherosclerosis, multiple sclerosis, and rheumatoid arthritis. Applicants do not acquiesce to the rejection, nonetheless, in order to expedite prosecution, Applicants have amended the claims, and reserve the right to pursue canceled subject matter in another application. In view of the amendments to the claims, Applicants respectfully submit that rejection is overcome. It is respectfully requested that the rejection of claims 1-9, 13-30, 34-36, 80, 83 and 84 under 35 U.S.C. § 112, first paragraph, be withdrawn.

IV. CLAIM REJECTION UNDER 35 U.S.C. § 112, SECOND PARAGRAPH

Claims 1, 2, 4, 7-9, 13, 14, 18, 21, 23-25, 27-36, 80, 83 and 84 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite, allegedly in connection with the recitation of “CCR4 mediated condition.” Applicants do not acquiesce to the rejection, and reserve the right to pursue subject matter canceled in the instant amendments to the claims in a later application. The rejection of claims 1, 2, 4, 8, 9, 13, 14, 24, 25, 27, 34, 35, 80, 83 and

84 is moot in view of the cancellation of these claims. Moreover, claims 7, 18, 21, 23, 28-33 and 36 have been amended and do not recite the phrase “CCR4 mediated condition,” nor do these claims depend from a claim reciting the phrase. For these reasons, it is respectfully requested that the rejection of claims 1, 2, 4, 7-9, 13, 14, 18, 21, 23-25, 27-36, 80, 83 and 84 under 35 U.S.C. § 112, second paragraph, be withdrawn.

V. DOUBLE PATENTING

Claims 1, 2, 4, 7-9, 13-30, 32-36, 80, 83 and 84 stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 82, 83, 85-91 and 96-122 of co-pending U.S. Patent Application No. 2003/0018022 A1. Applicants hereby request that the rejection be held in abeyance until allowable subject matter is indicated, at which time Applicants might file a Terminal Disclaimer or take other appropriate action.

VI. CLAIM REJECTION UNDER 35 U.S.C. § 103(a)

Claims 1, 2, 4, 7-9, 13-33, 36, 80, 83 and 84 stand rejected under 35 U.S.C. § 103(a) for obviousness over U.S. Patent No. 4,826,990 (Musser *et al.*). The rejection of claims 1, 2, 4, 8, 9, 13-16, 19, 20, 24-27, 80, 83 and 84 is moot in light of the cancellation of these claims. Applicants respectfully traverse the rejection of claims 7, 17, 18, 21-23, 28-33, 36, each of which depends from new independent claim 85, which is not included in the rejection.

Further, Applicants respectfully submit that new claim 85 is patentable under 35 U.S.C. § 103(a) over Musser *et al.* For example, Musser *et al.*, do not teach or suggest compounds that are recited for use in instant claim 85. The generic chemical formula described in Musser *et al.* does not overlap that recited in instant claim 85. In addition, the compounds described in Musser *et al.* are enzyme inhibitors possessing lipoxygenase inhibitory activities (*see, e.g.*, Musser *et al.*, col. 1, lines 6-8, and col. 20, lines 7-64) whereas the compounds recited for use in claim 85 modulate CCR4 receptors (*see, e.g.*, Specification, page 12, lines 4-34, and page 45, tbl. 1). For these reasons, claim 85 is fully patentable under 35 U.S.C. § 103(a) over Musser *et al.*

Since claims 7, 17, 18, 21-23, 28-33, 36 each depend from claim 85, and include the limitations of claim 85, it is respectfully submitted that each one of claims 7, 17, 18, 21-23, 28-33, 36 is patentable under 35 U.S.C. § 103(a) over Musser *et al.*

Applicants respectfully request that the Patent Office withdraw the rejection of claims 1, 2, 4, 7-9, 13-33, 36, 80, 83 and 84 under 35 U.S.C. § 103(a).


CONCLUSION

In light of the above amendments and remarks, Applicants respectfully request that the Patent Office reconsider this application with a view towards allowance.

No fee is believed to be due with this paper. However, the Commissioner is hereby authorized to charge any required fee(s) to Jones Day Deposit Account No. 50-3013.

Respectfully submitted,

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